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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PASS, NATALIE

ART UNIT

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3626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/892,857	KOGURE, KENJI	
	Examiner	Art Unit	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11, 13-26 and 28-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11, 13-26 and 28-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) <input type="checkbox"/> Notice of Informal Patent Application
6) <input type="checkbox"/> Other: _____. |
|---|--|

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 19 July 2007. Claims 1, 9, 11, 23, 26, 34, 36 have been amended. Claims 2, 12, and 27 have been previously cancelled. Claim 37 has been newly added. Claims 1, 3-11, 13-26, 28-37 remain pending.

Claim Objections

2. Applicant is advised, as discussed in the previous Office action (paper number 20070404) that should claims 13, 16 be found allowable, claims 15, 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

3. The rejections of claims 1, 9, 11, 23, 26, 34, 36, under 35 U.S.C. 112, first paragraph, for containing new matter, is hereby withdrawn due to the amendment filed 19 July 2007.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

5. Claims 1, 3-11, 13-26, 28-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverbrook et al, U.S. Patent Number 6, 959, 298 for substantially the same reasons given in the previous Office Action (paper number 20070404). Further reasons appear hereinbelow.

(A) The amendments to claims 1, 9, 11, 23, 26, 34, 36 appear to have been made merely to correct minor typographical or grammatical errors or to overcome claim objections or rejections under 35 USC § 112. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20070404, section 8, pages 5-11), and incorporated herein.

(B) Claims 3-8, 10, and 13-22, 24-25, 28-33, 35 have not been amended and are rejected for the same reasons given in the previous Office Action (paper 20070404, section 8, pages 5-11), and incorporated herein.

6. Newly added claim 37 is rejected under 35 U.S.C. 102(b) as being anticipated by Mitcham et al, U.S. Patent Number 5537315.

(A) As per newly added claim 37, Mitcham teaches a method of engaging a group of customers having common personal data in a single collective contract or a plurality of individual contracts with another party, the method comprising:

creating a group registration data from registration data of a first customer that is common to a group, the registration data of the first customer (Mitcham; Abstract, Figures 3A to 3G, column 2, lines 64-67, column 4, lines 13-31, column 5, lines 1-4) inputted via a display device (Mitcham; Figure 1, column 3, lines 61-67);

inputting via the same display device the at least name of other members of the group (Mitcham; Figure 13, column 5, lines 9-43, 50-51, column 7, line 54 to column 8, line 10); and

executing the single collective contract or the individual contracts with respect to the group of customers based on the registration data of the first customer and the merged registration data of the remaining customers of the group (Mitcham; Figure 13, Figure 14A, column 4, lines 9-26, column 7, line 54 to column 8, line 10).

Response to Arguments

7. Applicant's arguments filed 19 July 2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 19 July 2007.

(A) At pages 10-13 of the 19 July 2007 response, Applicant argues that the features in the Application are not taught or suggested by the applied reference. In response, all of the limitations which Applicant disputes as missing in the applied references have been fully addressed by the Examiner as being fully disclosed in view of the teachings of Silverbrook, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20070404), and incorporated herein. Specifically, Examiner notes that the recited features of inputting data into interactive input forms "via an input of the display controller common to all customers" are taught by the applied reference. In particular, Examiner interprets Silverbrook's teachings of

"[t]he system also includes a sensing device to convey data from the form to the computer system, and in some instances, to contribute additional data. Again, the sensing device may take a variety of forms but is preferably compact and easily portable. In a particularly preferred arrangement, the sensing device is configured as a pen which is designed to be able to physically mark the form as well as to selectively enable the coded data from the form to be read and transmitted to the computer system. The coded data then provides control information, configured such that designation thereof by a user

causes instructions to be applied to the software running on the computer system or network” (Silverbrook; column 4, lines 22-33)

together with Silverbrook’s teachings of

“the preferred form of the netpage system employs a computer interface in the form of a mapped surface, that is, a physical surface which contains references to a map of the surface maintained in a computer system. The map references can be queried by an appropriate sensing device” (Silverbrook; column 7, lines 52-57)

and Silverbrook’s teachings of

“[a]s illustrated in FIG. 1, a printed netpage 1 can represent an interactive form which can be filled in by the user ... [...] ... "electronically", via communication between the pen and the netpage system” (Silverbrook; column 8, lines 20-23) to teach a form of inputting data “via an input of the display controller common to all customers,” and “[a]ll input is captured as digital ink” (Silverbrook; column 22, lines 45-47)

to teach a form of inputting data into interactive input forms “via an input of the display controller common to all customers.”

With respect to Applicant’s assertion at paragraph 1 at page 12 of the 19 July 2007 response that “Figure 51 is simply a table that does not teach or suggest how the insurance policy is put together ... [...] ...” Examiner respectfully notes that this is not a claimed limitation. In addition, Examiner notes that Applicant appears to rely upon only a small subset of Examiner’s applied art. Further, it is the entire combined applied reference(s), and not only the cited passages that must be considered when evaluating whether or not the applied references teach the cited limitations. Nevertheless, Examiner notes that Silverbrook teaches that “[t]he ... [...] ... system

provides efficient mechanisms for airlines or travel companies to offer products and services to customers. Travel services can include enquiries about ... [...] ... travel insurance” (emphasis added) (Silverbrook; column 46, lines 32-36) and “[e]ach [insurance] policy covers one or more travelers” (Silverbrook; column 47, line 66 to column 48, line 2), and furthermore, Examiner notes that Figures 81 and 82 of the Silberbrook reference also incorporate insurance for a group of travelers. As per Applicant’s arguments paragraph 1 at page 12 that Silverbrook does not teach that “the information of a representative user is entered prior to inputting the common personal data of the remaining customers of a group,” Examiner notes that this is not a claimed limitation. Examiner notes, however, that any member of a group can be designated as “a representative user” and the Silverbrook reference allows any member of the group to be entered first.

As per Applicant’s arguments in the last paragraph on page 12 that Silverbrook fails to disclose an input of the display controller common to all users because Figure 63 teaches that “there are two input devices as two forms would be required to input the registration data for a representative user and the remaining members of the group,” Examiner respectfully disagrees. Firstly, Examiner notes that the form displayed in Figure 63 allows for all the members of the group to be entered on one form with an input of the display controller. Secondly, it is respectfully submitted that the type of information disclosed as stored, processed, and displayed within the Silverbrook system, as recited in the above passages, broadly reads on the claimed “via an input of the display controller common to all customers.”

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark

"EXPEDITED PROCEDURE".

For informal or draft communications, please label

"PROPOSED" or "DRAFT" on the front page of the

communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Natalie A. Pass/

Examiner, Art Unit 3626

February 18, 2008

/Robert Morgan/

Primary Examiner, Art Unit 3626